

REMARKS

Applicant gratefully acknowledges the Examiner's indication that claims 53-58, 82-86, and 90-92 are allowed. Applicant requests reconsideration of this application in view of the following remarks and accompanying amendments. Claims 1-58, 82-86, and 90-100 were pending prior to the instant amendment. By this amendment, Applicant herein amends claims 1, 4, 6, 9-11, 14, 15, 40, 47, 92, 95, and 98. As a result, claims 1-58, 82-86, and 90-100 remain pending in the instant application.

35 U.S.C. § 112, Sixth Paragraph

On page 4 of the instant Office Action the Examiner recites that the "means" statements that appear in the apparatus claims fail to invoke the proper 35 U.S.C. § 112, sixth paragraph, format and that, thus, the functional language included in the apparatus claims will be without supporting structure. Applicant amends claims 1, 4, 6, 9-11, 14, 15, 40, 47, 92, 95, and 98 herein to properly invoke 35 U.S.C. § 112, sixth paragraph.

Claim Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1-10, 12, 13, 16-25, 29, 31, 32, 34-39, and 94-100 stand rejected under 35 U.S.C. § 102(e) as anticipated by de Boer et al. (U.S. Pub. No. 2005/0018201 A1). Claims 11, 14, 26-28, 30, 33, 40-46, 52, and 93 stand rejected under 35 U.S.C. § 103(a) as unpatentable over de Boer. Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over de Boer in view of Applicant's admitted prior art. Applicant traverses these rejections for at least the reason that independent claims 1, 4, 6, 40, 93, 94, 95, and 98, as amended herein, recite features not taught or suggested by the cited prior art of record.

For example, the cited prior art of record fails to teach the features,

displacing means for laterally displacing at least one of the object beam and the reference beam to produce a relatively displaced object beam and a relatively displaced reference beam;

[...]

optical spectrum dispersing means for receiving the relatively displaced object beam and the relatively displaced reference beam on at least partially different portions of the optical spectrum dispersing means due to lateral displacement of the two relatively displaced beams caused by the displacing means, and for dispersing the spectral content of the two displaced beams onto a reading element such that the dispersed relatively displaced reference beam and the dispersed relatively displaced object beam are superposed on the reading element;

recited in claim 1, or analogous features recited in the other independent claims. The

Examiner has already indicated that such features are not taught by the cited prior art reference. Specifically, on page 13 of the October 29, 2009 Office Action, the Examiner stated,

the prior art of record, taken alone or in combination, fails to disclose or render obvious *displacing the reference and object beams laterally and projecting them onto different portions of the optical spectrum dispersing means*, in combination with the rest of the limitations of the claim

However, in the instant Office Action the Examiner indicates that,

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the displacing means) are not recited in the rejected claim(s).

Independent claim 1 clearly recites "displacing means" and "lateral displacement" of relatively displaced beams. Applicant understands the Examiner's position to be that, because the "means" recited in claim 1 fails to invoke proper 35 U.S.C. § 112, sixth paragraph, format, that these limitations that the prior art fails to teach are merely functional language in the apparatus claims and, thus, provide no structure. Applicant submits that the apparatus claims, as amended herein, invoke proper 35 U.S.C. § 112, sixth paragraph, format and, thus, the "means for" should be construed to be means for all the limitations of structure that are disclosed in the specification. Accordingly, Applicant submits that independent claims 1, 4, 6, 40, 93, 94, 95, and 98 each recite structure not disclosed by the cited prior art of record, namely means for displacing the reference and object beams laterally and dispersing means for receiving the beams on different portions.

For at least the foregoing reasons, the cited prior art of record fails to disclose each and every feature recited in independent claims 1-46, 52, and 93-100. Thus, Applicant respectfully submits that only with the benefit of hindsight knowledge gleaned from Applicant's own disclosure would a person of ordinary skill in the art be able to arrive at Applicant's claimed invention. For at least these reasons, Applicant respectfully requests reconsideration and removal of the rejections of claims 1-46, 52, and 93-100.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

NIXON PEABODY LLP

/Jeffrey L. Costellia, Reg.#35,483/
Jeffrey L. Costellia
Registration No. 35,483

NIXON PEABODY LLP
CUSTOMER NO.: 22204
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000